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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY L. HOOPMAN

Appeal 2008-5399¹
Application 10/749,601
Technology Center 3700

Decided:² February 25, 2009

Before LORA M. GREEN, RICHARD M. LEBOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

¹ The real party in interest is the inventor, Timothy L. Hoopman (App. Br. 3 (filed September 30, 2006)).

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a pack of playing cards with judiciously placed indicia. The Examiner has entered alternative rejections for anticipation and obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's obviousness rejection.

STATEMENT OF THE CASE

Claims 1, 2, 8, and 9 stand rejected and are on appeal (App. Br. 3).³

Claims 1, 2, 8, and 9 read as follows:⁴

1. A pack of playing cards comprising cards having indicia in judicious placement to lessen both precision of vertical columnar alignment and columnar length over that obtainable with a previously known pack of playing cards.
2. The playing card pack of claim 1 wherein the pack comprises
a series of cards each having a face and a back, the cards being organized into four suits with thirteen cards in each suit having one of 13 different values, and each face having a top edge, a bottom edge, a left edge and a right edge;
the faces on the cards having two diagonally opposing primary corners and two diagonally opposing secondary corners, and first indicia and second indicia in regions that border at least one edge, the second indicia having a height that is similar in length to or less than that of the first indicia, wherein the first indicia denote a characteristic common

³ Appeal Brief filed September 30, 2006. If prosecution resumes in this case, the Examiner and Appellant should work together to ensure that non-appealed claims 3-7 and 10-17 are canceled. *See Ex Parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf>, slip op. at 5-6 (Bd. Pat. App. & Int. May 1, 2008) (precedential).

⁴ The "Appeal Brief Supplement" filed January 7, 2008, contains the correct version of the claims on appeal.

throughout the series of either a suit or a value and the second indicia denote the remaining characteristic;
the first indicia being in at least a first position and a second position on the faces of the cards in regions proximate the primary corners, the first indicia in the first position being in the region of the primary corner formed by the top edge and the left edge and having a right-reading orientation, and the first indicia in the second position being in region of the primary corner formed by the bottom edge and the right edge and having an upside-down-reading orientation; and
the second indicia being in at least a first position and a second position on the faces of the cards, the second indicia in the first position having a right-reading orientation, being horizontally proximate to the right-reading first indicia and being in a region bordering the top edge, and the second indicia in the second position having an upside-down-reading orientation, being horizontally proximate to the upside-down-reading first indicia and being in a region bordering the bottom edge.

8. The playing card pack of claim 1 where the playing cards have a familiar appearance through use of a graphic to denote both value and suit of each card, wherein the graphic is centrally located on each face and wherein the graphic is a grouping if a Spot Card or a picture if a Face Card and the picture has an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down.

9. The playing card pack of claim 8 wherein the pack comprises
a series of cards each having a face and a back, the cards being organized into four suits with thirteen cards in each suit having one of 13 different values, and each face having a top edge, a bottom edge, a left edge and a right edge;
the faces on the cards having two diagonally opposing primary

- corners and two diagonally opposing secondary corners, and first indicia and second indicia in regions that border at least one edge, the second indicia having a height that is similar in length to or less than that of the first indicia, wherein the first indicia denote a characteristic common throughout the series of either a suit or a value and the second indicia denote the remaining characteristic;
- the first indicia being in at least a first position and a second position on the faces of the cards in regions proximate the primary corners, the first indicia in the first position being in the primary corner region formed by the top edge and the left edge and having a right-reading orientation, and the first indicia in the second position being in the primary corner region formed by the bottom edge and the right edge and having an upside-down-reading orientation; and
- the second indicia being in at least a first position and a second position on the faces of the cards, the second indicia in the first position having a right-reading orientation and being in a region bordering the top edge and extending to the right of the right-reading first indicia but not within a region proximate to the secondary corner formed by the top edge and the right edge, and the second indicia in the second position having a upside-down-reading orientation and being in a region bordering the bottom edge and extending to the left of the upside-down-reading first indicia but not within a region proximate to the secondary corner formed by the bottom edge and the left edge.

The Examiner applies the following documents in rejecting the claims:

Stauff

US Des. 181,884

Jan. 7, 1958

The following rejection is before us for review:

Claims 1-17 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Stauff (Ans. 3-6).

DISCUSSION

ISSUE

The Examiner cites Stauff as disclosing a deck of playing cards with first indicia (numerical values) and second indicia (suit) that are horizontally aligned along the cards' top and bottom edges (Ans. 3).

The Examiner finds that Stauff meets the limitations of claim 1 because the positions of the first and second indicia on Stauff's cards makes them “**capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known pack of playing cards” (Ans. 4). The Examiner also finds that Stauff's cards meet the limitation in claims 2 and 9 requiring the first and second indicia to be “horizontally proximate” because, when interpreted broadly, the relative term “proximate” encompasses the value and suit indicia positions shown in Stauff (*id.*).

The Examiner further finds, however, that Stauff differs from claims 2 and 9 in that the second indicia (suit) is not in the first position (upper left corner) in a right-reading orientation, or in the second position (lower right corner) in an upside-down reading orientation (*id.* at 5). The Examiner also concedes that Stauff differs from claim 8 in not having Face Cards with an upper half in right-reading orientation and a lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down (*id.*).

The Examiner nonetheless reasons that Stauff anticipates claims 2, 8, and 9 because the differences between Stauff's cards and the claimed cards "only reside in the meaning and information conveyed by **printed matter**. Such differences are considered unpatentable" (*id.*).

Alternatively, regarding claims 2 and 9, the Examiner urges that a person of ordinary skill in the art would have considered it obvious "to modify Stauff's playing cards by positioning the second indicia (suit) in the first position in a right-reading orientation in the top edge, [and] positioning the second indicia (suit) in the second position in an upside-down-reading orientation in the bottom edge" (*id.* at 6). The Examiner presents a similar alternative rationale with respect to claim 8, urging that an ordinary artisan would have considered it obvious to "replac[e] the pictures in Stauff's Face Cards with pictures having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down" (*id.*).

Appellant contends that the Examiner erred in finding that Stauff anticipates claim 1, because it is insufficient that Stauff is capable of performing the functions recited in claim 1, and because Stauff fails to meet a number of limitations in the dependent claims (*see* App. Br. 7-8). Appellant further contends that the Examiner erred in interpreting the recitation "horizontally proximate" as encompassing Stauff's cards (*id.* at 8-9).

Appellant also contends that the Examiner erred in failing to accord patentable weight to the orientations and positions of the indicia on the cards because those features have a functional relationship with the cards:

That combination permits columns of shorter length and columns with less precise columnar alignment than obtained with known decks of playing cards; a result with significant benefits in games like Solitaire when played on small tables as those in an airplane and hospital trays, and Bridge, particularly Contract Bridge where tables are numerous and smaller than normal (see Specification pages 1-6, 11, 21).

(*Id.* at 11-12.)

In view of the positions advanced by Appellant and the Examiner, the issue with respect to this rejection is whether the Examiner erred in finding that Stauff anticipates claims 1, 2, 8, and 9, or alternatively, whether the Examiner erred in concluding that a person of ordinary skill in the art would have considered claims 1, 2, 8, and 9 obvious in view of Stauff.

FINDINGS OF FACT (“FF”)

1. Claim 1 recites a pack of playing cards in which the cards have indicia “in judicious placement to lessen both precision of vertical columnar alignment and columnar length over that obtainable with a previously known pack of playing cards.”
2. Appellant’s Figure 1, reproduced below, provides an example of a pack of cards that meets that limitation:

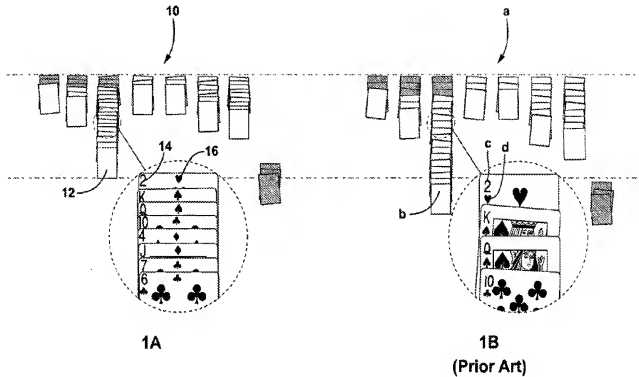


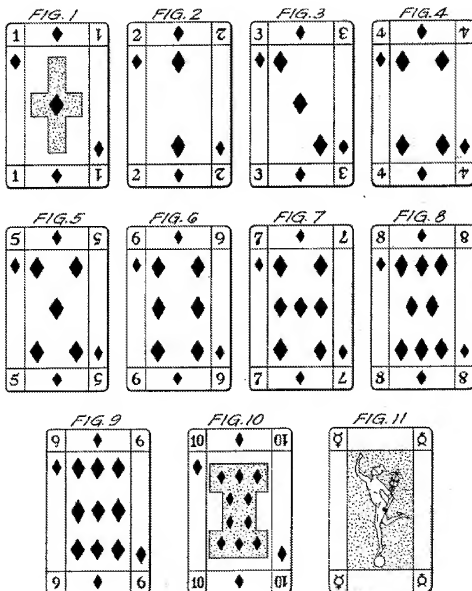
Figure 1 shows “an overhead or plan view showing the playing area during the Solitaire game Scorpion. 1A illustrates the view with cards of the invention while 1B (Prior Art) illustrate[s] the view with typical cards that are previously known” (Spec. 12).

3. As seen in Figure 1, because the first indicia (value) and second indicia (suit) are horizontally aligned along the top edge of the cards shown in 1A, and because the suit indicia are shorter in height than the value indicia in 1A, “the overall length of a long column (12) is less in Figure 1A than a long column (b) in Figure 1B. Resulting play is less unwieldy because both first indicia (14) and second indicia (16) in a magnified section of Figure 1A

are visible in a column when vertical displacement is sufficient to reveal the first indicia" (Spec. 18-19).

4. As also seen in Figure 1, "[a]lignment precision is decreased as the horizontally aligned second indicia approach the midpoints between primary and secondary corners" (Spec. 12).

5. Figures 1-11 of Stauff are reproduced below:



Figures 1-10 show the ace and spot cards of the diamond suit of a deck of cards, and Figure 11 shows the joker.

6. Figures 12-23 of Stauff are reproduced below:



Figures 12-14 show a face view of the jack, queen, and king of hearts, Figures 15-17 show a face view of the jack, queen, and king of diamonds, Figures 18-20 show a face view of the jack, queen, and king of clubs, and Figures 21-23 show a face view of the jack, queen, and king of spades.

7. Stauff discloses that its deck of playing cards “consists of a joker and four suits of 13 cards, the aces and spot cards of each suit having the design shown in Figs. 1-10, except that the suit indicia utilized on each of these cards varies according to the suit indicia shown in Figs. 12-23” (Stauff 2).

8. Like the cards shown in Appellant’s Figure 1A, Stauff’s cards have value and suit indicia horizontally aligned along the cards’ top edges, have suit indicia which are slightly smaller than the value indicia, and have the suit indicia aligned at about the midpoint of the cards’ top edges.

9. As shown on page 3 of the Affidavit of Tim Hoopman (App. Br. 26 (Evidence Appendix)), it was known in the art to configure face cards such that the face picture has an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. *See also* Spec. 16 (“Since 1870, cards commonly are both double-headed, which permits them to be right-reading on top regardless of which narrow end is on top, and equipped with indicia in the corners that allow the player to identify the suit and value of many cards at the same time when in a fanned arrangement.”).

PRINCIPLES OF LAW

During examination, the PTO must interpret terms in a claim using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into

account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727 (2007), the Supreme Court addressed the question of obviousness, and reaffirmed that, under the controlling inquiry, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved," and that "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.* at ___, 127 S. Ct. at 1734 (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)). The Court stated that "[i]f a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103." *KSR*, 127 S. Ct. at 1734.

The Court also reasoned that the analysis under 35 U.S.C. § 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 1741. The Court further advised that "[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton." *Id.* at 1742.

Applying these concepts, the Court ultimately reaffirmed "that when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would

expect from such an arrangement, the combination is obvious.” *Id.* (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976)).

It is well settled that evidence of unexpected results may rebut an examiner’s prima facie case of obviousness. *See In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *see also KSR*, 127 S. Ct. at 1740 (“The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams’s design was not obvious to those skilled in the art.”) (discussing *United States v. Adams*, 383 U.S. 39 (1966)).

However, “[m]ere improvement in properties does not always suffice to show unexpected results. . . . [W]hen an applicant demonstrates *substantially* improved results . . . and *states* that the results were *unexpected*, this should suffice to establish unexpected results *in the absence of* evidence to the contrary.” *In re Soni*, 54 F.3d 746, 751 (Fed. Cir. 1995).

Thus, “any superior property must be *unexpected* to be considered as evidence of non-obviousness.” *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1371 (Fed. Cir. 2007). Moreover, “when unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.” *In re Baxter-Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991).

ANALYSIS

Appellant’s arguments do not persuade us that the Examiner erred in concluding that a person of ordinary skill in the art would have considered claims 1, 2, 8, and 9 obvious in view of Stauff.

With respect to claim 1, the cards in the claimed deck must have indicia “in judicious placement to lessen both precision of vertical columnar alignment and columnar length over that obtainable with a previously known

pack of playing cards” (FF 1). As seen from Appellant’s Figure 1, those limitations are met by cards having the first indicia (value) and second indicia (suit) horizontally aligned along the top edges of the cards, with the value indicia at the top left corner and suit indicia in a central location along the top edges, and the suit indicia being shorter in height than the value indicia (FF 2-4).

As seen in Stauff’s Figures 1-23, Stauff’s cards have precisely those features (FF 5, 6). We are therefore not persuaded that Stauff’s cards fail to meet all of the limitations of claim 1.

Thus, because Stauff’s pack of cards meets all of the limitations in claim 1, we agree with the Examiner that Stauff renders claim 1 *prima facie* obvious. *See Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) (“[A]nticipation is the epitome of obviousness.”).

Claim 2 depends from claim 1, and requires the first indicia to be present in the top left corner of the cards in a right-reading orientation, and in the bottom right corner in an upside-down reading orientation. Second indicia must also be present in at least two locations, the first location being “horizontally proximate” to the top-left, right-reading first indicia, in a right-reading orientation, and the second location being “horizontally proximate” to the bottom-right, upside-down-reading first indicia, in an upside-down-reading orientation.

The Examiner concludes that, even if one interprets claim 2 as not encompassing Stauff’s top- and lower-edge suit indicia, an ordinary artisan would have considered it obvious “to modify Stauff’s playing cards by positioning the second indicia (suit) in the first position in a right-reading orientation in the top edge, [and] positioning the second indicia (suit) in the

second position in an upside-down-reading orientation in the bottom edge” (Ans. 6). We agree.

As the Supreme Court pointed out in *KSR*, “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 127 S. Ct. at 1741. (quoting *Sakraidu v. AG Pro, Inc.*, 425 U.S. 273 (1976)).

In the instant case, one of ordinary skill in the art would have reasonably inferred that Stauff’s cards would function equally well if the suit indicia were relocated from their central locations on the top and bottom edges to locations directly adjacent to the value indicia in the top-left and bottom-right corners. Similarly, one of ordinary skill in the art would have reasonably inferred that the suit indicia on the top and bottom edges of Stauff’s cards would function equally well if they were inverted from the orientations shown in Figures 12-14, and 18-23. We therefore agree with the Examiner that claim 2 would have been *prima facie* obvious in view of Stauff.

Claim 8 depends from claim 1 and requires the playing cards to have a centrally located graphic denoting value and suit, and if the card is a face card, to have a picture with an upper half in a right-reading orientation, and a lower half with an upside-down reading orientation, such that the graphic looks similar whether seen right-side up or upside down. The Examiner concludes that, even if one interprets claim 8 as not encompassing Stauff’s face cards, the ordinary artisan would have considered it obvious to “replac[e] the pictures in Stauff’s Face Cards with pictures having an upper half in a right reading orientation and similar lower half in an upside-down

reading orientation such that the graphic looks similar whether seen right-side up or upside down” (Ans. 6).

Again, we agree. Specifically, one of ordinary skill in the art would have reasonably inferred that Stauff’s cards would perform their intended functions equally well if the pictures on the face cards were configured to have an upper half in a right-reading orientation, and a lower half with an upside-down reading orientation, such that the graphic looks similar whether seen right-side up or upside down.

Moreover, as Appellant effectively concedes, face cards with pictures configured in that manner were known to function suitably (*see* FF 9). We therefore do not agree with Appellant that the Examiner failed to make out a *prima facie* case of obviousness for claim 8.

Claim 9 depends from claim 8, and requires the first indicia to be present in the top left corner of the cards in a right-reading orientation, and in the bottom right corner in an upside-down reading orientation. Second indicia must also be present in at least two locations, the first location being along the card’s top edge but not proximate to the top right corner, in a right-reading orientation, the second location being along the bottom edge but not proximate to the bottom left corner, in an upside-down reading orientation.

The suit indicia at the top and bottom edges of Stauff’s cards are centrally located along the edges (FF 5, 6). The suit indicia of Stauff’s cards therefore meet the location requirements for the second indicia recited in claim 9.

Thus, assuming, for argument’s sake only, that the printed matter limitations in the claims carry patentable weight, claim 9 differs from Stauff only in that the suit indicia along the top and bottom edges of Stauff’s cards

are inverted, and that the pictures on Stauff's face cards do not have an upper half in a right-reading orientation, and a lower half with an upside-down reading orientation, such that the graphic looks similar whether seen right-side up or upside down (*see* FF 6).

However, as discussed above with respect to claim 2, we agree with the Examiner that it would have been obvious to invert the suit indicia at the top and bottom edges of Stauff's cards. Moreover, as discussed above with respect to claim 8, we agree with the Examiner that it would have been *prima facie* obvious to provide Stauff's face cards with a picture with an upper half in a right-reading orientation, and a lower half with an upside-down reading orientation, such that the graphic looks similar whether seen right-side up or upside down that configuration. We therefore do not agree with Appellant that the Examiner failed to make out a *prima facie* case of obviousness for claim 9.

In sum, Appellant's argument do not persuade us that the Examiner failed to make a *prima facie* case that claims 1, 2, 8, and 9 would have been obvious to a person of ordinary skill in the art in view of Stauff. We acknowledge Appellant's assertions that playing cards configured as claimed have significant advantages over certain types of cards known in the prior art (*see* FF 2-4; *see also* Affidavit of Tim Hoopman (FF 9)).

However, we are not persuaded that the asserted advantages are evidence of unobviousness that is sufficient to rebut the Examiner's *prima facie* case. Specifically, Appellant does not point to, and we do not see, any evidence that a person of ordinary skill in the art would have considered it *unexpected* that Stauff's cards could be arranged in columns shorter than the cards used in Appellant's comparisons (FF 2, 9). *Cf. Pfizer, Inc. v. Apotex*,

Inc., 480 F.3d at 1371 (“[A]ny superior property must be *unexpected* to be considered as evidence of non-obviousness.”).

Moreover, the cards used in Appellant’s comparisons are significantly less similar to the claimed cards than Stauff’s cards. That is, Stauff appears to be much closer prior art than the cards used in Appellant’s comparisons. Appellant’s comparisons therefore do not persuade us of unobviousness. *See In re Baxter-Travenol Labs.*, 952 F.2d at 392. (“[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.”).

In sum, because the Examiner has made a prima facie case that Appellant has failed to adequately rebut, we affirm the Examiner’s rejection of claims 1, 2, 8, and 9 as being obvious over Stauff. Because we agree with the Examiner that claims 1, 2, 8, and 9 would have been obvious to a person of ordinary skill under 35 U.S.C. § 103(a), we do not address the Examiner’s alternative rejection under 35 U.S.C. § 102(b).

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

LP

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